

Office Action Response
Application No.: 10/789,814
Babish, J., et al.
August 7, 2006

RECEIVED
CENTRAL FAX CENTER
AUG 07 2006

REMARKS

Reexamination and reconsideration in light of the forgoing amendments and following remarks is respectfully requested.

I. AMENDMENTS

Claims 1 through 7 are pending.

Claim 7 has been amended to remove R' substituents wherein R' is selected from the group consisting OR, and OCOR, wherein R is alkyl.

Claim 7 has been further amended to insert O as an R' substituent. Support for the use of O as a substituent may be found at, for example, Figures 2, 3A and 3B, and paragraphs [0022 – 0023].

Claim 7 has additionally been amended to provide antecedent basis for the terms RIAA and IAA in response to the Examiner's 35 USC § 112 second paragraph rejection.

The Applicants aver that the amendments to the claims presented *supra* are supported by the specification as filed and published and do not add new matter. The Applicants respectfully request entry of the claims as amended.

II. CLAIM REJECTIONS UNDER 35 USC § 112

Claim 7 stands rejected under 35 USC § 112 second paragraph as failing to provide sufficient antecedent basis for the limitation "said RIAA and IAA". The Applicants accept this rejection and have amended the claim *supra* to provide antecedent basis for the cited claim limitation. As such, the Applicants respectfully request withdrawal of this rejection.

Claim 7 additionally stands rejected under 35 USC § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which

(4)

BST99 1512300-1.068911.0075

Office Action Response
Application No.: 10/789,814
Babish, J., et al.
August 7, 2006

the applicant regards as the invention based on the phrase "wherein R is alkyl". The Applicants respectfully disagree with the assertion that "wherein R is alkyl" is indefinite insofar as this form of description for a substituent group when used in a genus formula is common to the chemical arts. However, the Applicants have, in the interest of furthering prosecution, have amended claim 7 to remove substituent groups wherein R is alkyl. As such, the Applicants respectfully request withdrawal of this rejection.

III. CLAIM REJECTIONS UNDER 35 USC § 103

Claims 1 – 7 stand rejected under 35 USC § 103(a) as being unpatentable for obviousness over Kuhrts (US 2004/0137096, PTO-892, hereinafter "Kuhrts").

The Applicants seek to remove Kuhrts as a prior art reference for purposes of overcoming the current 35 USC § 103(a) rejection. Towards that end the Applicants have appended to this response a declaration pursuant to 37 C.F.R. § 1.131 prepared by named first inventor John Babish providing copies of laboratory records evidencing conception and diligent research directed towards the instant invention, such evidence predating the January 9, 2003 filing date for the cited Kuhrts reference. As such, the Applicants respectfully request withdrawal of this rejection.

IV. DOUBLE PATENTING

Claims 1 – 7 have been provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1 – 115 of copending Application No: 10/464,410.

Claims 4 – 7 have been provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1 – 34 of copending Application No: 10/484,834.

(5)

BST99 1512300-1.068911.0075

Office Action Response
Application No.: 10/789,814
Babish, J., et al.
August 7, 2006

Claims 1 – 3 have been provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1 – 12 of copending Application No: 10/689,856 and over claims 1 – 6 of copending Application No: 10/774,048.

The Applicants offer to submit and accept terminal disclaimers linking any of the cited copending applications to the instant application should the instant case proceed to allowance and if the prosecuting Examiner maintains, in the copending cases cited, a rejection under the judicially created doctrine of obvious-type double patenting as being unpatentable over the instant case.

V. CONCLUSION

On the basis of the foregoing remarks and amendments, Applicants respectfully submit that amended claims 1 – 7 are in condition for allowance. Passage to issue is respectfully requested.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, The Examiner is requested to call Applicants' attorney at the telephone number shown below.

A Request for a Three (3) Month Extension of Time, up to and including August 07, 2006 is included herewith. Pursuant to 37 C.F.R. § 1.136(a)(2), the Examiner is authorized to charge any fee under 37 C.F.R. § 1.17 applicable in this instant, as well as in future communications to Deposit Account 50-1133. Furthermore, such authorization should be treated in any concurrent or future reply requiring a petition for an extension of time under 37 C.F.R. § 1.136 for its timely submission, as constructively incorporating a petition for extension of time for the appropriate time pursuant 37 C.F.R. § 1.136(a)(3) regardless of whether a separate petition is included.

(6)

BST99 1512300-1.068911.0075

Office Action Response
Application No.: 10/789,814
Babish, J., et al.
August 7, 2006

Respectively submitted,
MCDERMOTT WILL & EMERY LLP



Simona A. Levi-Minzi, Ph.D.
Registration No. 43,750
Attorney for Applicants

McDermott Will & Emery LLP
28 State Street
Boston, MA 02109
Telephone: 617.535.4049
Email address: slevi@mwe.com

Date: August 7, 2006

(7)

BST99 1512300-1.068911.0075